Attorney Docket No.: 42390.P9914 Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:

Steven E. Berile

Serial No.: 09/752,611

Filed: December 29, 2000

For: Concatenated Audio Title

Art Unit: 2644

Examiner: Graham, Andrew R.

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APPEAL BRIEF

IN SUPPORT OF APPELLANT'S APPEAL

TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Sir:

Pursuant to Appellant's Notice of Appeal filed August 19, 2005, appellants hereby submit this Brief and fee under 37 C.F.R. § 1.17(c) in appeal of the Final Rejections as set forth in the Final Office Action ("FOA") dated May 19, 2005 and the Advisory Action ("AA") dated August 12, 2005. Appellant respectfully requests consideration of this Appeal by the Board of Patent Appeals and Interferences for allowance of the claims in the above-captioned patent application.

I. REAL PARTY IN INTEREST

The invention is assigned to Intel Corporation of 2200 Mission College Boulevard, Santa Clara, California 95052.

II. RELATED APPEALS AND INTERFERENCES

To the best of Appellant's knowledge, there are no appeals or interferences related to the present appeal that will directly affect, be directly affected by, or have a bearing on the Board's decision.

III. STATUS OF CLAIMS

Claims 1-20 are pending in the application. Claims 1-20 stand finally rejected. The rejections of independent Claim 1 and its dependent claims, independent Claim 6 and its dependent claims, independent Claim 11 and its dependent claims, as well as independent claim 16 and its independent claims are appealed.

IV. STATUS OF AMENDMENTS

The only amendment in this case, filed April 12, 2004 has been entered, and is reflected in the listing of claims included in the Appendix (section VIII, below).

V. SUMMARY OF CLAIMED SUBJECT MATTER

Embodiments of the present invention provide for the automated concatenation of an audio title to an audio file.

Claim 1, for example, pertains to a method comprising reading descriptive information about an audio file (e.g., Fig. 1, 132) from meta-data (e.g., Fig. 1, 120) for the audio file and concatenating at least a portion of an audio format of the descriptive information to the audio file.

Claim 6, for example, pertains to a method comprising reading descriptive information about an audio file (e.g., Fig. 1, 132) from meta-data (e.g., Fig. 1, 120) for the audio file. The method further comprises mixing an audio format of at least a portion of the descriptive information with the audio file and generating a new audio file (e.g., Fig. 1, 136) containing audio data resulting from the mixing.

Claim 11, for example, pertains to an article that comprises a machine-readable media comprising instructions which, when executed by a processor, result in reading descriptive information about an audio file (e.g., Fig. 1, 132) from meta-data (e.g., Fig. 1, 120) for the audio file and concatenating at least a portion of an audio format of the descriptive information to the audio file.

Claim 16, for example, pertains to a system that comprises a processor. The system further comprises a machine-readable media comprising instructions which, when executed by a processor, result in reading descriptive information about an audio file (e.g., Fig. 1, 132) from meta-data data (e.g., Fig. 1, 120) for the audio file and concatenating at least a portion of an audio format of the descriptive information to the audio file.

Additional variants are disclosed and represented in the dependent claims.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL.

The issues for consideration on this appeal are:

A. Whether the Examiner erred in rejecting claims 1-2, 5-8, 10-12, 15-17, and 20 under 35 U.S.C. § 103(a) as being obvious over Sato (US 2001/0027396 A1) ("Sato") in view of Fitzpatrick et al. (USPN 5,675,708) ("Fitzpatrick"); and

B. Whether the Examiner erred in rejecting claims 3-4, 9, 13-14, and 18-19 under 35 U.S.C. § 103(a) as being obvious over Sato (US/0027396 A1) in view of Fitzpatrick et al. (USPN 5,675,708) and in further view of Yumura et al. (USPN 5,834,670) ("Yumura").

ARGUMENT

All Claims (1 – 20) are Patentable Over Sato, Fitzpatrick and Yumura

A. Claims 1 – 2, 5-8, 10 – 12, 15 – 17, and 20 are not rendered obvious by Sato in view of Fitzpatrick.

Claims 1 – 2, 5-8, 10 – 12, 15 – 17, and 20 stand rejected under 35 U.S.C. § 103(a) as being as being obvious over Sato (US 2001/0027396 A1) ("Sato") in view of Fitzpatrick et al. (USPN 5,675,708) ("Fitzpatrick"). However, Sato and Fitzpatrick fail to disclose, suggest or teach, either alone or in combination, all limitations for each rejected claim. Accordingly, the Final Office Action and Advisory Action fail to make a prima facie case of obviousness for such claims.

The legal requirements for a prima facie case of obviousness are clear. "The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness." MPEP § 2142. It is well established that *prima facie* obviousness is only established when three basic criteria are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (MPEP 2144).

(i) ***Regarding "concatenating ... to the audio file."***

Claims 1, 11and Claim 16 each recite "concatenating at least a portion of an audio format of the descriptive information to the audio file." The Final Office Action has failed to make out a prima facie case of obviousness regarding this limitation.

Sato discloses a device that generates audio output based on text information associated with an audio file. However, Sato does not disclose "concatenating" an audio format of information to the audio file. Instead, when a song is played, a "voice synthesizer" is used to generate audio output, based on "text information" associated with

the song. Rather than concatenating the synthesized voice to the audio file, Sato simply plays the synthesized voice through a speaker. (Para. 55.)

Sato also discusses a "read-out timing setting unit" for managing "a timing at which the text information is read out with respect to reproduced music data" (para. 69). This feature of Sato confirms the conclusion that Sato does not teach concatenating an audio format of information to the audio file. Instead, Sato uses the audio data in the audio file only to generate the music, while using text information to generate the synthesized voice.

During prosecution, the Examiner asserted regarding the Sato reference that "[t]he synchronism between the playing of the audio file and audio data from the synthesizer reads on the concept of 'concatenating at least a portion of an audio format of the descriptive information'." The Examiner appears to have backed off from this position (see following paragraph), but Applicants wish to assert their argument against this position for the record. Applicants respectfully assert that rendering of audio information from a synthesizer is not concatenation.

The Examiner has admitted during prosecution that Sato does not specify "that the concatenating of the at least a portion of the audio format of the descriptive information is executed to an audio file." (Office Action, p. 4). Applicants agree.

The Office Action attempts to remedy this deficiency in the prima facie showing of obviousness by relying on Fitzpatrick. However, such reliance must fail. The legal requirements for a prima facie case of obviousness are clear. "The Office Action bears the initial burden of factually supporting any prima facie conclusion of obviousness." MPEP § 2142. The cited references must teach or suggest <u>all</u> the claim limitations in order for a prima facie case of obviousness to lie. MPEP § 2142 (emphasis added).

Neither Sato nor Fitzpatrick, alone or in combination, discloses, suggests or teaches "concatenating at least a portion of an audio format of the descriptive information <u>to the audio file</u>". (Claims 1, 11, and 16, in part, emphasis added). Fitzpatrick discloses instead *translating or converting* a multimedia data stream or file to an audio media. See Fitzpatrick, Col. 3, lines 15-20. Specifically, the Fitzpatrick input file is an input file to

be converted to audio media; it is initially "a file system file or a standard input device type of data stream file resulting from data input which contains multimedia information, a subset of which is audio." The Fitzpatrick input file is not an audio file -- it may include video elements, graphical elements, document format control, etc. See Fitzpatrick, Col. 3, lines 61-65.

The Final Office Action and Advisory Action take the position that, because the input file of Fitzpatrick (which is not an audio file) may include audio elements, it satisfies the burden of making a prima facie case of obviousness with respect to concatenating "to the audio file." They argue that, because one can go from beginning to end of the flowchart shown in Fig. 2 of Fitzpatrick without traversing blocks 320 – 380, Fitzpatrick discloses processing for an audio-only file such as a file having the music data shown in Sato. However, such is not the case.

One cannot traverse from beginning to end of the flowchart in Fig. 2 without executing block 225. At block 225, a counter regarding audio entities in the file is initialized to zero. Thus, it is anticipated that non-audio entities may be encountered in the input file. If audio is encountered, block 270 must also be executed. Accordingly, the flowchart of Fig. 2 contemplates non-audio components of the input file; Fitzpatrick simply does not suggest, disclose or teach concatenating information to "the audio file" for which the metadata has been read.

Thus, Fitzpatrick simply does not, either alone or in combination with Sato, disclose, suggest, or teach "concatenating at least a portion of an audio format of the descriptive information to the audio file". (Claims 1, 11 and 16, in part).

Neither Sato nor Fitzpatrick, either alone or in combination, teaches this limitation of Claims 1, 11, and 16. Neither one discloses, teaches or suggests "concatenating at least a portion of an audio format of the descriptive information to the audio file" for which meta-data has been read. Claims 1, 11 and 16 are allowable for at least these reasons. Dependent claims 2 – 5, 12 – 15, and 17 - 20 are also allowable for at least these reasons.

(ii) ***Regarding "mixing an audio format of at least a portion of the descriptive information with the audio file" and "generating a new audio file containing audio data resulting from the mixing."***

The Final Office Action has failed to make a prima facie case of obviousness regarding Claim 6 at least because neither Sato nor Fitzpatrick disclose, teach or suggest "mixing an audio format of at least a portion of the descriptive information with the audio file" and "generating a new audio file containing audio data resulting from the mixing." (Claim 6, in part). Furthermore, the Examiner has failed to provide an appropriate motivation for combining the references.

Neither the Sato or Fitzpatrick reference teaches, discloses, or suggests "generating a new audio file containing audio data resulting from the mixing". In the Advisory Action, the Examiner states that "Sato discloses mixing an audio signal ... [and] Fitzpatrick teaches the handling of digital audio signals to form an intermediate output file." Advisory Action, p. 5. The salient point, however, is that neither or Sato teaches or suggests the claimed limitations. [Applicants do not claim "handling" of digital audio signals.]

As is argued above, Sato does not disclose, teach or suggest "generating a new audio file containing audio data resulting from the mixing". Rather than concatenating the synthesized voice to the audio file, Sato simply plays the synthesized voice through a speaker. (Para. 55.) Sato does not generate an audio file.

Similarly, Fitzpatrick also fails to disclose, teach or suggest "generating a new audio file containing audio data resulting from the mixing", at least because Claim 6 recites that the mixing relates to "descriptive information" about the audio file. Because Sato does not show the generating of an audio file, the Examiner's rejection must fail because, as is discussed below, Fitzpatrick does not show this element either.

Fitzpatrick discloses that a multimedia input file or data stream may include audio entities such as textual words or phrases, music, audio recordings, etc. (Fitzpatrick, Summary). Fitzpatrick further indicates that block 250 of Fig. 2 provides "a determination of whether the entity retrieved is human discernible. A human discernible

entity is an audio sound, a text word which can be converted to a spoken word, a text phrase which can be converted to a spoken phrase, music, or any sound which is natural for a human to hear and understand." (Fitzpatrick, Col. 3, ll. 55 – 60). However, Fitzpatrick does not disclose, suggest or teach that the human discernible entity may be meta data that includes descriptive information about an audio file, as recited in Claim 6.

Even if the cited references did, individually, disclose all elements of 6 (which assertion Applicant vigorously disputes), a prima facie case of obviousness is still not made out. The mere fact that a reference can be modified does not render the resultant combination obvious unless the prior art also ***suggests*** the desirability of the combination.

Indeed, Fitzpatrick teaches away from the technique of Sato. That is, the problem that Fitzpatrick seeks to solve is the loss of non-discernable data that the human ear cannot understand (such as video or graphics data) from a converted audio file. See Fitzpatrick, Col. 3, lines 57 – 61. If Fitzpatrick did, as the Office Action claims, teach "concatenating at least a portion of an audio format of the descriptive information to the audio file" such that the initial audio and metadata were contained in an input audio file, then no non-discernable data would be present in such input file, and the motivation behind the Fitzpatrick disclosure would be obviated. Thus, combining Fitzpatrick with Sato would obviate the need for Fitzpatrick, because the Sato file would not include non-discernable data.

Thus, Fitzpatrick does not read on "generating a new audio file ...." "[H]andling of digital audio signals" as asserted in the Advisory Action does not teach, suggest, or disclose the limitation of "generating a new audio file containing audio data resulting from the mixing." This is true at least for the reason that the claim limitations of Claim 6 make it clear that the claimed mixing is performed in relation to "descriptive information" mixed with the initial "audio file". Even if Applicants were to concede to the Advisory Action's characterization that Sato discloses mixing an audio signal, the Advisory Action is fatally flawed because is fails to make a prima facie showing of "generating a new audio file containing audio data resulting from the mixing."

Thus, neither reference, either alone or in combination, shows the recited elements. A prima facie showing of obviousness regarding Claim 6 has not been made out – Claim

6 is therefore allowable for at least this reason. Also, all claims that depend from Claim 6, Claims 7 – 10, are also allowable for at least this reason.

B. Claims 3-4, 9, 13-14, and 18-19 are not rendered obvious by Sato in view of Fitzpatrick and in further view of Yumura

Claims 3-4, 9, 13-14, and 18-19 stand rejected under 35 U.S.C. § 103(a) as being obvious over Sato (US/0027396 A1) in view of Fitzpatrick et al. (USPN 5,675,708) and in further view of Yumura et al. (USPN 5,834,670) ("Yumura"). However, the Office Action fails to make a prima facie case of obviousness, and such rejections should be withdrawn.

Yumura relates to a karaoke apparatus that generates synthesized speech in association with music. However, Yumura does not disclose or suggest "concatenating" an audio format of descriptive information to an audio file (claims 1, 11, 16) or generating "a new audio file" that contains "audio data" resulting from "mixing" the audio file with "an audio format" of descriptive information (claim 6). For the reasons set forth above, neither does Sato or Fitzpatrick. Consequently, even if Sato, Fitzpatrick and Yumura were to be combined, the combination would not disclose or suggest all of the features recited in Claims 3-4, 9, 13-14, and 18-19.

"When the references cited by the examiner fail to establish a prima facie case of obviousness, the rejection is improper and will be overturned." In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988). Accordingly, all independent claims are in condition for allowance. For at least the foregoing reasons, all dependent claims are also in condition for allowance.

Appellant respectfully submits that all pending claims in this patent application are patentable, and requests that the Board of Patent Appeals and Interferences overrule the Examiner and direct allowance of the rejected claims.

If any fee insufficiency or overpayment is found, please charge any insufficiency or credit any overpayment to Deposit Account No. 02-2666.

Respectfully submitted,

Dated: December 19, 2005

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VIII. CLAIMS APPENDIX

1. (original) A method comprising:

reading descriptive information about an audio file from meta-data for the audio file; and

concatenating at least a portion of an audio format of the descriptive information to the audio file.

2. (original) The method of claim 1 further comprising:

converting the descriptive information to the audio format prior to concatenating.

3. (original) The method of claim 1 wherein at least a portion of the audio format of the descriptive information is concatenated to the beginning of the audio file.

4. (original) The method of claim 1 wherein the concatenating is performed in response to an operation to transfer the audio file from a first computer system to a second computer system.

5. (original) The method of claim 1 wherein the audio file comprises the meta-data.

6. (previously amended) A method comprising:

reading descriptive information about an audio file from meta-data for the audio file;

mixing an audio format of at least a portion of the descriptive information with the audio file; and

generating a new audio file containing audio data resulting from the mixing.

7. (original) The method of claim 6 further comprising:

converting the descriptive information to the audio format prior to mixing.

8. (original) The method of claim 6 wherein at least a portion of the audio format of the descriptive information is mixed with audio at the beginning of the audio file.

9. (original) The method of claim 6 wherein the mixing is performed in response to an operation to transfer the audio file from a first computer system to a second computer system.

10. (original) The method of claim 6 wherein the audio file comprises the meta-data.

11. (original) An article comprising:

a machine-readable media comprising instructions which, when executed by a processor, result in;

reading descriptive information about an audio file from meta-data for the audio file; and

concatenating at least a portion of an audio format of the descriptive information to the audio file.

12. (original) The article of claim 11 further comprising instructions which, when executed by the processor, further result in:

converting the descriptive information to the audio format prior to concatenating.

13. (original) The article of claim 11 wherein concatenating further comprises:

concatenating at least a portion of the audio format of the descriptive information to the beginning of the audio file.

14. (original) The article of claim 11 wherein the concatenating is performed in response to an operation to transfer the audio file from a first computer system to a second computer system.

15. (original) The article of claim 11 wherein the audio file comprises the meta-data.

16. (original) A system comprising:

a processor; and

a machine-readable media comprising instructions which, when executed by the processor, result in;

reading descriptive information about an audio file from meta-data for the audio file; and

concatenating at least a portion of an audio format of the descriptive information to the audio file.

17. (original) The system of claim 16 further comprising instructions which, when executed by the processor, further result in:

converting the descriptive information to the audio format prior to concatenating.

18. (original) The system of claim 16 wherein concatenating further comprises:

concatenating at least a portion of the audio format of the descriptive information to the beginning of the audio file.

19. (original) The system of claim 16 wherein the concatenating is performed in response to an operation to transfer the audio file from a first computer system to a second computer system.

20. (original) The system of claim 16 wherein the audio file comprises the meta-data.